REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-9 and 12-22 were pending in this application. In this Amendment, Applicants have amended claims 1, 2, 7, 8, 14-17, and 20-22. Accordingly, claims 1-9 and 12-22 will still be pending upon entry of this Amendment.

In the Office Action mailed December 30, 2005, the Examiner asserted the following rejections: (1) claims 1-9 and 12-22 under 35 U.S.C. § 112, ¶ 1, for failing to comply with the written description and enablement requirements; (2) claims 7, 8, and 16 under 35 U.S.C. § 112, ¶ 2 for being indefinite; (3) claims 1-9 and 12-22 under 35 U.S.C. § 101 as directed to non-statutory subject matter; (4) claims 1-7 and 12 under 35 U.S.C. § 102 as anticipated by U.S. Published Patent Application 2002/0059093 to Barton et al. ("Barton"); and (5) claims 8, 9, and 13-22 under 35 U.S.C. § 103(a) as unpatentable over Barton. To the extent the rejections might still be applied to claims presently pending in this application, Applicants respectfully traverse the rejections as set forth below under subheadings corresponding to the rejections.

35 U.S.C. § 112, ¶ 1

In rejecting independent claims 1-9 and 12-22 under § 112, ¶ 1, the Examiner stated that "the results of the claimed invention are entirely subjective and non-repeatable, thereby failing to produce a concrete result." (Pages 2-3, 7, and 8 of the 12/30/05 Office Action.) In particular, the Examiner asserted that because the recited methods rely purely on subjective input and analysis, the methods are not concrete, would yield different results depending on who performs

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the functionality, and are therefore unrepeatable and unpredictable. (Page 3 of the 12/30/05 Office Action.) Applicants respectfully submit, however, that the methods recited in amended independent claims 1, 14, and 20 do provide repeatable results because, although different users may provide different content for a display, the recited display illustrates the content in a uniform, consistent manner. In other words, the methods for illustrating of claims 1, 14, and 20 result in the *display* of information in a consistent structure, regardless of the content provided to populate that structure.

To emphasize this point, Applicants have amended claims 1, 14, and 20 to recite the receiving of processes, elements, and actors as defined by a user, the receiving of the associations between the processes, elements, and actors as defined by a user, and then the displaying of the processes, elements, and actors in a particular structure that illustrates the associations between the processes, elements, and actors. In one example, the structure is a matrix in which the processes are plotted along row headers, the elements are plotted along column headers, and the actors are listed at the intersections of the processes and the elements, as is shown in the exemplary matrix of Figure 1E of the present application, which relates to information technology outsourcing. Thus, addressing the Examiner's questions about any analysis of the organization taking place, the amended claims 1, 14, and 20 do not involve any such analysis. Rather, the claims recite methods for providing a display from which such analyses can be performed, by for example the user.

To help clarify the features of the recited inventions, the exemplary display shown below illustrates a more simplistic application of the invention related to sandwich making, which

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displays associations between processes (*e.g.*, gathering and spreading), elements subject to

those processes (*e.g.*, turkey and bread), and actors associated with those processes and elements

(*e.g.*, food prep person and chef).

	Bread	Mustard	Lettuce	Turkey
Gathering	Food Prep	Food Prep	Food Prep	Food Prep
Washing	n/a	n/a	Food Prep	n/a
Drying	n/a	n/a	Food Prep	n/a
Cutting	Food Prep	n/a	Food Prep	Food Prep
Spreading	Chef	Chef	Chef	Chef
Assembling	Chef	n/a	Chef	Chef

Thus, this exemplary matrix structure can present any desired processes, elements, and

actors, and the associations therebetween, in a display from which a user can formulate, for

example, a scope of work. The invention therefore is repeatable and predictable in that it

provides a display structure that associates given processes, elements, and actors. The content of

the display may change depending on the processes, elements, and actors defined by the user, but

the *structure* of the display as recited in the claims is repeatable and predictable. In addition, this

display structure is fully supported by the present application at, for example, paragraphs [0083-

86] and Figure 1E, which provides the requisite written description and does not require undue

experimentation to practice the invention.

Applicants therefore respectfully submit that amended independent claims 1, 14, and 20,

as well as dependent claims 2-13, 15-19, 21, and 22, comply with the written description and

enablement requirements of 35 U.S.C. § 112, ¶ 1.

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35 U.S.C. § 112, ¶ 2

In rejecting independent claims 7, 8, and 16 under § 112, the Examiner stated that Applicant's use of the term "outsourcer" is contrary to the generally accepted meaning of the term and that the specification does not clearly redefine the term to set forth the uncommon definition so as to put the skilled artisan on notice of the redefined term. (Pages 3, 4, and 10 of the 12/30/05 Office Action.)

Applicants respectfully disagree with the Examiner's assertions and refer to several portions of the specification that both define the term "outsourcer" and also equate it with the term "supplier," such as in paragraphs [0004], [0005], and [0033]. For example, these portions refer to "a supplier (or outsourcer)," "outsourcers/suppliers," "supplier/outsourcer," and "an outsourcer (supplier)." The specification goes on to describe functions of an organization being outsourced to a supplier, for example, at paragraph [0007]. Therefore, as explained in the Amendment filed December 6, 2005, the specification defines an outsourcer or supplier as an entity to which an operation is outsourced. Furthermore, Applicants note that the Examiner's rejection relies on a newly created definition, where in fact the dictionary to which the Examiner refers apparently does not explicitly define the term "outsourcer." In addition, Applicants note that the definition of outsourcer provided in Applicants' disclosure is commonly used by those of ordinary skill in the art of outsourcing. (*See, e.g.*, the article "Walk Like An Outsourcer," March 1, 2003, CIO Magazine, attached as Exhibit 1.) Applicants therefore respectfully submit that the term "outsourcer" is not vague or indefinite

Nonetheless, to advance prosecution, Applicants have amended claims 7, 8, and 16 to recite the term "supplier" instead of "outsourcer." Applicants therefore respectfully submit that claims 7, 8, and 16 comply with 35 U.S.C. § 112, ¶ 1.

35 U.S.C. §§ 102 and 103(a)

The Examiner rejected claims 1-22 as either anticipated by or obvious in view of Barton, in each case stating that Barton discloses a process, an element subject to the process, and an actor associated with the process and element. Applicants respectfully submit, however, that Barton at best discloses associated processes and actors, but fundamentally lacks any teaching of an element – let alone an *associated* element – as that feature is defined in the present application and claims.

The present invention displays on a single display associations between processes of a value chain, elements subject to the processes, and actors responsible for furnishing the elements. As described at, for example, paragraph [0038] of the present specification, elements are the objects that are subject to the processes, which can be thought of as the nouns that appear in the description of the processes. As one example, in the context of information technology outsourcing, the process of customer relationship management technical support could be performed using PC workstations. In the simplistic sandwich making example discussed above, turkey would be the element subject to the processes of cutting and assembling. Thus, the association displayed by the present invention not only conveys the relationship between a process and an actor (*i.e.*, which actor is responsible for completing which process), but also conveys what element is used in completing the process.

This three-way association displayed by the present invention enables an organization to conveniently understand the scope of an outsourcing transaction, in terms of which actor (*e.g.*, the outsourcer or the organization itself) is furnishing which element to complete a certain process. One example of a displayed association is the process-span matrix 110 shown in Figure 1E. This matrix 110 can display the association between processes 114, elements of span 112, and actors at the intersections (*e.g.*, intersection 116), as described at, for example, paragraphs [0084] and [0099] of the present application. Figure 24 provides another example of a display illustrating the association between actors, processes, and elements. As described, for example, at paragraph [00185] of the present application, the process-span matrix 2400 associates processes 2402 with elements of a span 2404, and associates characteristics with the associated processes and elements as represented at intersections of the matrix. As the specification describes, by clicking on the "scope" tab in the graphical user interface, actors would be displayed as the associated characteristic displayed in the matrix. Barton fails to teach or suggest such displayed associations at least because it lacks any teaching of an element subject to a process.

Barton is directed to methods for identifying and mitigating business risks. (*See, e.g.*, Abstract.) As such, Barton associates processes with risks. An object of Barton is to proactively monitor and measure compliance with company policies. (¶ [0007].) The policies, or "processes" elements, that are assessed include leadership commitment, training, resources, discipline, and enforcement. (¶ [0039].) Barton gathers the risk data associated with these

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process elements by interviewing and questioning the person responsible (*i.e.*, "process owner")

for each of the processes. (¶ [0057].)

To identify a process owner for each process element (and its corresponding questions),

the process elements are mapped against the process owners, with notations (*e.g.*, "x") indicating

which process owner is responsible for which process element, as shown in the owner's matrix

100 of Figure 4 of Barton. Notably, this matrix 100 provides only a simple one-to-one

correlation between process element and process owner, and associates nothing else with the

associated owner and process element. In essence, matrix 100 is merely a tool for identifying the

individuals (process owners) from which to obtain the risk data.

After gathering risk data, the data is summarized in a risk QFD matrix 190. (Figure 13; ¶

[0077].) This matrix 190 associates processes (*e.g.*, marketing and product development),

categories of compliance risk (*e.g.*, Spirit & Letter and Contractual), and risk scores. Matrix 190

is therefore a tool for summarizing and prioritizing the risks for a business. Notably, however,

because Barton focuses on the risk to the business, matrix 190 not only fails to teach or suggest

an association between process, element, and actor, but also provides no insight whatsoever into

the actors performing the processes.

As the Examiner correctly notes, Barton teaches a spreadsheet (Figure 4) that associates

the responsible persons with the processes. However, neither the spreadsheet nor Barton's

disclosure addresses elements that are subject to the processes. The portions of the spreadsheet

to which the Examiner equates the elements of the present invention are actually just further

descriptions of the processes. For example, the Examiner claimed that the "infrastructure" listed

in Figure 4 is an element that is subject to the processes of "leadership," "communication,"

"resources," and "discipline & enforcement." However, Barton specifically defines

"infrastructure" (as well as the other headings listed in the left column of the spreadsheet of

Figure 4) as compliance assessment areas 102, which are areas of a business that are being

reviewed for compliance. Such "areas" are simply categories under which the processes fall, and

are *not* elements that are used to complete the process. Thus, Barton is a simple one-to-one

correlation between actors and processes. There is no teaching whatsoever, of elements (*e.g.*, the

nouns subject to the processes – such as telephones or computers in an IT outsourcing).

Thus, Barton does not teach or suggest elements subject to processes and is instead

limited to displaying only associations between processes and actors. This is because Barton is

focused on risk compliance and assessing compliance in certain areas of an organization.

Examples of the compliance assessment areas include infrastructure, equal employment

opportunity, antitrust, trade controls, ethical business practices, and supplier relationships – all of

which are process related and none of which is an element (*i.e.*, a noun) subject to a process.

Importantly, nowhere does Figure 4 of Barton disclose associating a process and actor *with an*

element.

Applicants have also amended claim 20 to clarify a further distinction over Barton

relating to the display of interactions between an organization and a supplier and to the

association of those interactions with corresponding actors, processes, and elements. Amended

claim 20 recites the display of an interaction between an organization and an supplier that are

participating in an outsourcing, the process being accomplished in the interaction, the actors

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performing the process, and the elements being used to perform the process. Such interactions and association are shown, for example, in the interaction models of Figures 16, 17, and 21 and described at, for example, paragraph [00170] of the application. Because Barton fails to teach or suggest elements subject to processes, Barton necessarily fails to teach or suggest the display of interactions associated with elements. In addition, the Office Action cited Figures 4, 12, and 13 in reference to the particular swim-lane interaction models of claim 22, yet these figures do not show in any way interactions between an organization and an outsourcer participating in an outsourcing transaction, but instead relate to conveying risk scores associated with processes and categories of compliance risk, as explained above.

Applicants therefore respectfully submit that amended independent claims 1, 14, and 20 are patentable over Barton. Applicants also respectfully submit that dependent claims 1-9, 12, 13, 15-19, 21, and 22 are also patentable due at least to their dependence on an allowable base claim.

Applicants further note that in rejecting claims 8, 9, and 13-22, the Examiner relied on Official Notice or general assertions that claimed features would have been obvious to one of skill in the art. To these extent these rejections might still be applied to the claims currently pending, and pursuant to MPEP § 2144.03(C), Applicants respectfully traverse these rejections for the following specific reasons:

- Claims 8: Although outsourcing contracts are well-known, developing such contracts based on the recited display of associated processes, elements, and actors is not. The Examiner's Official Notice appears limited to outsourcing any

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processes. Thus, to the extent the Examiner relies on Official Notice to reject the inclusion of the recited display of associated processes, elements, and actors in a contract, Applicants respectfully request documentary evidence supporting such notice. Furthermore, Applicants respectfully traverse the Examiner's motivation for modifying Barton with this common knowledge. Although Barton may teach assessing the risks of outsourcing, nowhere does Barton teach or suggest the recited display of the scope of an outsourcing for inclusion in a contract. Indeed, Barton's has only one reference to "outsourcing," which appears in a laundry list of potential business risks and has nothing to do with analyzing outsourcing arrangements. (Paragraph [0069].)

• Claim 9: Although mergers are of course well-known, it is not well-known in the context of a merger to illustrate the operation of an organization through the recited display of associated processes, elements, and actors. The Examiner's Official Notice appears limited to assessing risks in a merger. Thus, to the extent the Examiner relies on Official Notice to reject claim 9, Applicants respectfully request documentary evidence supporting such notice. Furthermore, Applicants respectfully traverse the Examiner's motivation for modifying Barton with this common knowledge. Although Barton may teach assessing business risks in general, nowhere does Barton teach or suggest the recited display of associated processes, elements, and actors in the context of a merger. Indeed, Barton does contain any reference to a merger.

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- Claim 13: The Examiner's rejection admitted that Barton does not expressly define the steps of relating, developing, contacting, fulfilling, operating, advising, and managing, as processes mapped out against related elements, and asserted that it would be obvious to use these process labels. The Examiner then stated that it would have been obvious to one of ordinary skill in the art to use these process labels. However, this cited common knowledge fails to address the mapping of the processes to the elements. In other words, the Examiner provides no support for mapping the processes to the elements.

- Claims 14, 16, and 20-22: Although outsourcing is well-known, the present invention's use of the recited display of associated processes, elements, and actors is not. This display enables the illustration of the scope of an outsourcing or the interactions among parties to an outsourcing. In contrast, the Examiner's Official Notice appears limited outsourcing in general. Thus, to the extent the Examiner relies on Official Notice to reject the present inventions' illustration of an outsourcing scope or outsourcing interactions, Applicants respectfully request documentary evidence supporting such notice. Furthermore, Applicants respectfully traverse the Examiner's motivation for modifying Barton with this common knowledge. Although Barton may teach assessing the risks of outsourcing, nowhere does Barton teach or suggest the display of the scope of an outsourcing contract or interactions between parties of an outsourcing. Indeed, Barton's has only one reference to "outsourcing," which appears in a laundry list

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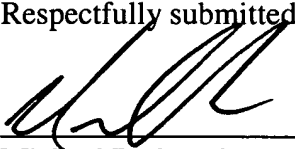
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of potential business risks and has nothing to do with analyzing outsourcing

arrangements. (Paragraph [0069].)

In light of these deficiencies, Applicants respectfully request that the Examiner provide

documentary evidence in the next Office Action.

In view of the foregoing, all of the claims in this case are believed to be in condition for

allowance. Should the Examiner have any questions or determine that any further action is

desirable to place this application in even better condition for issue, the Examiner is encouraged

to telephone Applicants' undersigned representative at the number listed below.

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Date: June 21, 2006

Respectfully submitted,

By: _____
Michael Bednarek
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Customer No. 00909

EXHIBIT 1

Faced with a tight economy, CIOs are scrutinizing everything—including outsourcing. A number of them have taken back the keys to their shops, saving lots of cash. Here's how you can do it too.

BY STEPHANIE OVERBY

Outsourcing

BRINGING I.T. BACK HOME

EXHIBIT 1

Cecilia Claudio

FARMERS GROUP

REVENUE: $11.5 billion

EMPLOYEES: 19,000

CONTRACT: A 10-year, $150 million IT outsourcing deal with Integrated Systems Solutions (now IBM Global Services) for mainframe IT support, application development and

Walk Like an Outsourcer

After ending an outsourcing deal e Group learns the key to successfu running its IT shop like an outsour

A FEW YEARS after leaving Xerox, C burned by a big-name outsourcer. Wl as CIO of Anthem Blue Cross and Blu she inherited a five-year, $30 million with Unisys. Claudio was dissatisfied and increasing costs, so she got out c rebid the work, ultimately going with Computer Services.

Since then, Claudio has proved that s how to get out of a bad situation but outsourced IT back in. As senior vice of Farmers Group, which she joined ii just that after the company acquired Insurance for $812 million in 2000. T Mich.-based provider of insurance for RVs was outsourcing all of its mainfrε application development and mainten company was eight years into a 10-y. arrangement with Integrated System division of IBM that eventually becam Global Services). Foremost Insurance outsourced the work for financial reas to Claudio, savings never materialize(were escalating. "They didn't have a : that allowed the customer to reap the cost of ownership going down over tii Claudio.

So after Farmers brought Foremost ir Claudio and her team chose to bring . house rather than offer it to another (

maintenance

PROBLEM: A back-loaded payment structure limited cost savings

SOLUTION: Terminated deal early and brought work in-house

RESULT: $6 million in annual savings

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Thinking of bucking the outsourcing trend too? Get the story from Farmers Group CIO Cecilia Claudio for the next two weeks when you **ASK THE SOURCE** at cio.com.

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doing that, she believed she would hε over the work being done and the co:

Although Farmers would have to pay cancellation fees and early terminatio Claudio's financial analysis showed th could recoup those initial costs within begin to save money.

First she had to break the news to thι which was difficult. "I pride myself on relationships with partners and vendc things lightly," explains Claudio. "It's partner and say, 'This is no longer wc not seeing the benefits.'"

Then there was the process of bringir aboard at Farmers. Those employees been boomeranged. Originally Forem· they lost their job when the IT work ι Then they had to be convinced to joir outsourcer. Now they were being ask Farmers employees. Claudio knew thε knowledge of the company and its sy critical, particularly during the transit "make it appealing not only on a prof on an emotional level." Although she them the variety of tasks and access technologies that the outsourcer prov promise stable positions at a compan employees. Ultimately she was able t percent of the original IT staff.

The entire reinsourcing process took : was completed in September 2000. C move paid off. "Within the first year, about $6 million a year."

The key has been running in-house Γ outsourcer. "[We're] a very lean orga achieving the best value for our monε explains. In fact, some say Claudio's more efficient than that of most outsι information technology costs coming revenue. William N. Pieroni, general r global insurance industry group, can · "Farmers' IT spending levels are less the major competitors, and that is no incredible given the scale and scope (

"It all starts with pride of ownership,' believe I can do as good a job if not ι aspects of running an IT shop than aι

◘ Walk Like an Outsourcer
◘ **The Vendor Strikes Back**

a When the Mission Changes, I¬

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